

### **REMARKS**

The pending claims are, Claims 241-242, 244-245, 248-249, 252-253, 256, 265-276, 278-289, 291-297, 299-303, 305-317, 319-329, 331-336, 338-348, 350-355, 357-359, 361-370.

#### **Amendment to Claim 272**

The word, “fragment”, needed to be deleted as the remainder of the claim indicates that “85 to 140 kDa” refers to a molecular weight range. (See similar phrases in Claim 303 step (3), Claim 311, and Claim 315, for examples of the correct language..)

**Rejection of Claims 241, 244, 245, 248, 249, 252, 253, 256-276, 278, 279, 280-289, 291-297, 299-303, and 305-316 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent**

**Application number 2003/0166017 (McCarthy) (Paragraph 7 of the Office Action)**

This rejection under **35 U.S.C. 102(e)** was maintained in the Office Action of July 9, 2010 (“the present Office Action”). On the other hand, the rejections under **35 U.S.C. 102(b)** (Paragraph 6 of the present Office Action) and **35 U.S.C. 103(a)** (Paragraph 8 of the present Office Action) were withdrawn in the present Office Action. Applicant believes that the reasoning that lead to the withdrawal of two of the rejections should have also resulted in withdrawal of the rejection under **35 U.S.C. 102(e)**.

The three rejections were set forth in detail in the Office Action of January 20, 2010, pages 7 – 13. Each rejection cited a reference considered by the Examiner to disclose an assay

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based on the plasma level thrombospondin fragments. The rejection of **35 U.S.C. 102(b)** cited Jackowski, which was directed at Alzheimer's Disease. The rejection of **35 U.S.C. 102(e)** cited McCarthy, which was directed at cardiovascular disease. The rejection of **35 U.S.C. 103(a)** cited PCT publication WO98/07035 which was directed at arthritis or, in the alternative, the combination of WO98/07035 and McCarthy (cardiovascular disease). As to all three rejections, Applicant argued that the reference(s) cited did not disclose, as Applicant's claims did, an assay directed at neoplastic disease. (See Amendment of May 6, 2010 at pages 28-32.)

In the Office Action of January 20, 2010, pages 7 – 13, each rejection also stated that remiss from the claims were the patient population measured and the populations the plasma levels are compared to. Again, for each rejection, Applicant responded in the same way: He argued the rejection was unjustified but, in any case, he amended the claims so that the remiss information was in the claims. (See Amendment of May 6, 2010 at pages 28-32.)

Finally, the fact that only the rejection under **35 U.S.C. 102(e)** was maintained cannot be explained in terms of which claims were rejected. The rejections under **35 U.S.C. 102(e)** and **35 U.S.C. 103(a)** were each directed at the same claims: 241, 244, 245, 248, 249, 252, 253, 256, 265-276, 278-289, 291-297, 299-303 and 305-316. (See present Office Action, paragraphs 7 and 8, taking into account that Claims 257-264 had been canceled). The withdrawn rejection under **35 U.S.C. 102(b)** was directed at Claims 241, 245, 248, 249, 253, 256 and 265-276. (Office Action, paragraph 6) all of which are among those still rejected under **35 U.S.C. 102(e)**.

In view of the foregoing, Applicant believes that his reason for traversing the rejection under **35 U.S.C. 102(e)**, as set forth in the Amendment of May 6, 2010 at pages 29-31, should be

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sufficient to overcome this rejection.

**Objection to Claim 309 (Paragraph 10 of the Office Action)**

Applicant has amended the Claim responsive to the objection.

**Rejection of Claims 241, 244, 245, 248, 249, 252, 253, 256, 265-276, 278, 291-297, 299-303, 305-317, 319, 331-336, 338-348, 350-355, 357-359 and 361 on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 7,655,411 B2 (issued February 2, 2010) (Paragraph 12 of the Office Action).**

In order to overcome this rejection, a terminal disclaimer is being co-submitted with this Response.

Should the Examiner believe that a telephone conversation would be useful, Applicant's undersigned attorney can be reached at **610-724-2952**.

Respectfully submitted,

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